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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,182	08/05/2003	Jie Jack Li	PC25274A	7102

28880 7590 07/28/2005  
WARNER-LAMBERT COMPANY  
2800 PLYMOUTH RD  
ANN ARBOR, MI 48105

EXAMINER

RAO, DEEPAK R

ART UNIT PAPER NUMBER

1624

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/634,182

Applicant(s)

LI, JIE JACK

Examiner

Deepak Rao

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-17 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

Claims 1-17 are pending in this application.

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-17, drawn to compounds of formula (I) wherein  $Y^4$  is  $-N=$  or  $-NH-$  and  $Y^3$ ,  $U^5$ ,  $U^6$  and  $U^8$  are each carbons; or  $Y^3$ ,  $Y^4$  and  $U^6$  are each carbons, one of  $U^5$  and  $U^8$  is N and the other is carbon (i.e., Quinoline core) corresponding composition and method of use, classified in class 546, subclass various.
- II. Claims 1-4, 9-10, 14 and 16-17, drawn to compounds of formula (I) wherein  $Y^3$ ,  $Y^4$ ,  $U^5$ ,  $U^6$  and  $U^8$  are carbons (i.e., Naphthalene core), corresponding composition and method of use, classified in class 560-564, subclass various.
- III. Claims 1-3, 9-10, 14 and 16-17, drawn to compounds of formula (I) wherein  $Y^4$  is  $-O-$ ;  $Y^3$ ,  $U^5$ ,  $U^6$  and  $U^8$  are each carbons (i.e., Benzopyran core), corresponding composition and method of use, classified in class 549, subclass various.
- IV. Claims 1-4, 9-10, 14 and 16-17, drawn to compounds of formula (I) wherein  $U^6$  is N,  $U^5$  and  $U^8$  are carbons and  $Y^3$  and  $Y^4$  are as defined in the claims (i.e., Isoquinoline, etc.); corresponding composition and method of use, classified in class 546, subclass various.
- V. Claims 1-4, 9-10, 14 and 16-17, drawn to compounds of formula (I) wherein  $U^6$  is carbon, one of  $U^5$  and  $U^8$  is N and the other is carbon and  $Y^4$  is  $-N=$ ,  $-NH-$  or  $-O-$

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(i.e., Naphthyridine core, etc.) corresponding composition and method of use, classified in class 546, subclass various.

The inventions are distinct, each from the other because of the following reasons:

The compounds of Groups I-V are drawn to structurally dissimilar compounds. They are made independently and used independently. They would be expected to raise different issues of patentability if a compound of Group I was anticipated, the anticipatory reference would not necessarily render obvious a compound of groups II-V or vice-versa. They are not art-recognized equivalents, they are separately classified and require separate burdensome searches both in the literature and computer databases.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their different classification and recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Claims 1-17 are generic to a plurality of disclosed patentably distinct species comprising the species disclosed in the Examples of the specification. In addition to election of a single group from above, applicant is required under 35 U.S.C. 121 to **elect a single disclosed species falling within the elected group**, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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This restriction is being set forth in writing due to its lengthy nature and to facilitate applicant with sufficient information, to make an informed and correct election of the invention applicants would wish to have prosecuted in the application.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Conclusion***

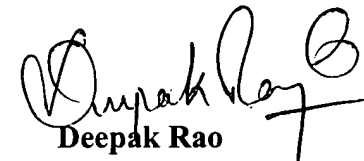
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deepak Rao whose telephone number is (571) 272-0672. The examiner can normally be reached on Tuesday-Friday from 6:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson, Acting-SPE of 1624, can be reached at (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**Deepak Rao**  
**Primary Examiner**  
**Art Unit 1624**

July 25, 2005